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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/610,768

07/06/2000

William P. Alberth JR.

CS10557

5526

7590 09/15/2009  
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EXAMINER

TRAN, TUAN A

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/610,768  
Filing Date: July 06, 2000  
Appellant(s): ALBERTH ET AL.

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Lawrence J. Chapa  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06/29/2009 appealing from the Office action mailed 08/07/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

Art Unit: 2618

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 4,12 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 4 and 12, as disclosed in the specification, the termination of sending the stored message is based on the detection of **depressing any keys on the subscriber unit** (See specification, page 9 lines 3-6) or the detection of the **user's voice signals** (See specification, figures 2-3, page 8 line 9 to page 9 line 2 and page 10 line 29 to page 11 line2), not the audio signals. The audio signals can be recorded upon initiating a call and transmitted as stored message or in combination with a pre-stored message when the call is established and the user's voice signals are not detected. Correction is required.

Claim 17 is rejected for the same reasons cited above.

***Allowable Subject Matter***

2. Claims 4 and 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Art Unit: 2618

The reasons for allowance have been indicated in the Office Action mailed on 03/21/2007.

3. Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The reasons for allowance have been indicated in the Office Action mailed on 03/21/2007.

4. Claims 1-2, 5-10, 13-16, 18-24 and 26-30 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The reasons for allowance have been indicated in the Office Action mailed on 03/21/2007.

#### **(10) Response to Argument**

With respect to the appellant's argument filed on 06/29/2009, the response(s) are follows:

The appellant argued that "voice signals are a usual and fair example of and a subset of audio signals, and consequently contrary to the Examiner's assertions are fully supportive and consistent with the specific claimed language" and "the Examiner has failed to identify a type of audio signal that would be inconsistent with a voice signal to a degree that, the embodiment making specific reference to a voice signal would not

Art Unit: 2618

fairly represent and support the claiming of a detection of an audio signal” (See Appeal Brief, Argument section, page 5). The examiner respectfully agrees with the appellant that voice signals are a subset of audio signals. However, in this instant case, the appellant is trying to obtain a patent which covers a whole set of audio signals including user’s voice, tones, music, noises, dog barking, bird chirping, sirens, etc, wherein as disclosed in the specification, the termination of sending the stored message is based on the detection of **depressing any keys on the subscriber unit** (See specification, page 9 lines 3-6) or the detection of the **user’s voice signals** (See specification, figures 2-3, page 8 line 9 to page 9 line 2 and page 10 line 29 to page 11 line2), and not any and all types of audio signal. Further, the audio signals can be recorded upon initiating a call and transmitted as stored message or in combination with a pre-stored message when the call is established and the user’s voice signals are not detected (See specification, figure 3 and col. 10 line 15 to col. 11 line 2, col. 11 lines 23-29). This is simply a matter of the applicant originally disclosing a narrow scope and then later attempting to gain patent coverage for a broader and larger scope. Hence the 112 rejection.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Tuan A Tran/

Art Unit: 2618

Primary Examiner, Art Unit 2618

09/12/2009

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Application/Control Number: 09/610,768  
Art Unit: 2618

Page 7